

REMARKS

In the Office Action dated January 28, 2003, the Examiner rejected claims 1, 3 and 5-26 under 35 U.S.C. §§ 102 and/or 103. In the following remarks, applicant will respond to those rejections and highlight the differences between the pending claims and the cited references such that it becomes apparent to the Examiner that these rejections should be reconsidered and withdrawn. Applicant has amended the claims to more clearly define the unique configuration of bristles that form the brush of the present invention.

In the January 28, 2003 Office Action, the Examiner rejected claims 1, 3 and 5-26 under 35 U.S.C. §§ 102 and 103 in view of Dorf U.S. Patent No. 6,039,051 ("Dorf"), Cervantes U.S. Patent No. 4,222,677 ("Cervantes"), and Gueret U.S. Patent No. 5,765,573 ("Gueret"). Applicant respectfully submits the Examiner's reliance upon the prior art is misplaced as applicant's invention is very different from what is disclosed in these references. In particular, applicant would like to direct the Examiner's attention to applicant's idea for an improved cosmetic brush having a uniquely designed tuft of bristles for enhanced applicability of eye make-up to the lashbed of the eyelids.

The present invention discloses an improved cosmetic brush having a uniquely designed tuft of bristles for enhanced applicability of eye make-up to the lashbed of the eyelids. Specifically, the cosmetic brush according to the claimed invention is an eyeliner brush having a unique tuft of bristles that has bristles configured such that the tuft has a tip portion having an arcuate shape (i.e., when viewed from the end of the brush) so as to conform to the shape and contour of the eyelash line. The brushes disclosed in the references relied on by the Examiner do not suggest such a novel brush.

Initially, the Examiner rejected claims 1, 7, 8, 14, and 16-24 under 35 U.S.C. § 102(e) as being anticipated by Dorf. Applicant respectfully submits that the Examiner's reliance on Dorf is misplaced. It

1 is black letter law that to be anticipatory, a prior art reference must disclose each and every element of the
2 claim or claims at issue -- Dorf clearly falls far short of this requirement.

3 Briefly, Dorf discloses a cosmetic brush having bristles specially configured in an arrangement for
4 the application of make-up specifically to the cheek. That is, Dorf teaches a brush having bristles that form
5 a tuft that is contoured so that the approximate length of the bristles vary across the width from a shorter
6 side to a longer side, such that a tapered portion is formed at each side of the width (i.e., such that the tip
7 or head of the brush when viewed from the side appears rounded with the edges being tapered). This is
8 very different from the present invention. Specifically, the invention claimed in the pending claims comprises
9 a tuft of bristles configured such that the tip end is arcuately shaped, and the thickness is substantially
10 uniform along the arcuate shape of the tuft. As claimed, the bristles comprising the tuft of the cosmetic
11 brush are aligned to form a curved or arcuately shaped tuft when viewed from the brushes end. This is very
12 different from the brush disclosed in Dorf. Therefore, the applicant respectfully requests that this rejection
13 be withdrawn as at least one element of the claimed invention in claims 1, 7, 8, 14, and 16-24 is not taught
14 or disclosed by Dorf.

15 Next, the Examiner rejected claims 1, 3 and 5-26 under 35 U.S.C. § 103(a) as being unpatentable
16 over Cervantes in view of Dorf and Gueret. Applicant respectfully submits that the Examiner's application
17 of the teachings of the cited references is misplaced. Applicant disagrees with the Examiner's opinion as
18 to the specific teachings of the cited references and any resulting combination thereof. In addition, the
19 Examiner's rejection could only be the result of hindsight reconstruction of the applicants' invention. More
20 importantly, even if the cited references were properly combined, such combination still would not teach
21 all of the novel and non-obvious features of the present invention as claimed.

1 Initially, applicant submits that Cervantes discloses a tool for the application of liquid eye make-up
2 where the bristles are tapered to a point. This is not the claimed invention. As is readily apparent, several
3 distinctions exist. First, nowhere does Cervantes teach or suggest using a ferrule to secure bristles to a
4 handle to form a brush. In fact, the use of a crimped ferrule in Cervantes' tool would interfere with the flow
5 of fluid to the bristles from the reservoir, and hence would not be used. Second, Cervantes also fails to
6 disclose a tuft of bristles aligned in a curved or arcuate pattern to conform to the contour of the lashline of
7 the eyes (i.e., at the base of and between the individual lashes). Also, a careful review of Cervantes shows
8 that the brush disclosed therein cannot be used effectively in the application of eyeliner to an eyelid like the
9 claimed invention.

10 Next, Gueret merely discloses an applicator for applying mascara. The bristles of the applicator
11 disclosed by Gueret are of different lengths and, in the embodiment referred to by the Examiner, configured
12 in a manner such that they form a straight line (not a curved or arcuate shape) when viewed from the end
13 of the brush. The concave (or curved appearance of the tuft of bristles occurs only when the brush is
14 viewed from the side. Such a configuration is very different from the claimed invention and cannot be used
15 in the effective application of a cosmetic to the lashbed of the eyelids like the claimed invention. In other
16 words, nowhere does Gueret disclose a configuration of a tuft of bristles for a cosmetic brush in a curved
17 or arcuate pattern like the claimed invention. In short, like Cervantes, Gueret fails to teach or suggest both
18 the use of a ferrule to secure bristles to a handle to form a brush as well as a tuft of bristles configured
19 whereby the tuft of bristles aligned in a curved or arcuate pattern along its width (when viewed from its end)
20 to facilitate application of cosmetic to the lashbed of the eyes.

21 Finally, as discussed above, Dorf fails to teach a cosmetic brush having a tuft of bristles aligned to

1 form a curved or arcuately shaped tuft when viewed from the brushes end to facilitate application of
2 cosmetic to the lashbed of the eyes.

3 Consequently, none of the references relied on by the Examiner teach or suggest each and every
4 element of the claimed invention of the pending claims. In fact, none of the cited references teach or
5 suggest a tuft of bristles aligned in a curved or arcuate pattern (when viewed from the end of the brush) to
6 form a brush head that conforms to the contour of the lashbed of the eyes to facilitate the accurate and
7 natural-looking application of cosmetic thereto. Therefore, applicant submits that the rejection of claims
8 1 and 26 as being unpatentable over Cervantes or Dorf or Gueret should be reconsidered. Upon closer
9 review of the cited references and in view of the amendments and remarks made herein above, applicant
10 submits that it will be apparent to the Examiner that the rejection of claims 1, 3 and 5-26 under 35 U.S.C.
11 § 103(a) should be withdrawn.

12 Despite the fact that a combination of the cited references does not teach the claimed invention,
13 applicant submits that the obviousness argument advanced by the Examiner is merely an "obvious to try"
14 argument. In fact, each of the brush designs disclosed in Cervantes, Dorf and Gueret are unsuitable for
15 application of a cosmetic to the lashbed of the eyes. Furthermore, it is impractical to add a crimped ferrule
16 to the brushes of Gueret and Cervantes, as it would interfere with their functionality. Accordingly, it cannot
17 be said that the present invention is obvious in view of any of Cervantes, Dorf and Gueret. At best it might
18 be "obvious to try" such a combination, which, of course, is not the standard for obviousness under 35
19 U.S.C. §103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

20 Under the circumstances, applicant re-submits that the Examiner has succumbed to the "strong
21 temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217

1 U.S.P.Q. 193, 199 (Fed. Cir. 1983). The only "motivation" for the Examiner's obviousness argument in
2 view of the cited references is provided by the teachings of applicant's own disclosure. No such motivation
3 is provided by the references themselves.

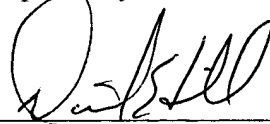
4 Therefore, as is evidenced by the above amendments and remarks, the present invention, for the
5 first time, discloses a cosmetic brush having a tuft of bristles aligned in a curved or arcuate pattern (when
6 viewed from the end of the brush) to form a brush head that conforms to the contour of the lashbed of the
7 eyes to facilitate the accurate and natural-looking application of cosmetic thereto. A cosmetic brush such
8 as this is neither taught nor suggested anywhere in the cited references.

9
10 **CONCLUSION**

11 In view of the foregoing, applicant respectfully submits that the present invention represents a
12 patentable contribution to the art and the application is in condition for allowance. Early and favorable
13 action is accordingly solicited.

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Respectfully submitted,



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